

TTAB



01-09-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #30

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

KEVIN T. McCARNEY dba)	
POQUITO MAS)	
Opposer,)	
v.)	Opposition Nos. 107,026 and 107,748
)	
UNA MAS, INC.)	
Applicant.)	
	x	

BRIEF OF OPPOSER
KEVIN T. McCARNEY dba
POQUITO MAS

**THIS DOCUMENT CONTAINS CONFIDENTIAL MATERIAL
COVERED BY A PROTECTIVE ORDER OF THE BOARD AND IS
SUBMITTED UNDER SEAL PURSUANT TO THAT PROTECTIVE
ORDER. THE CONTENTS OF THIS MATERIAL MAY NOT BE
DISCLOSED WITHOUT THE EXPRESS ORDER OF THE BOARD.**

I hereby certify that this correspondence is being deposited
with the United States Postal Service as first class mail in
an envelope addressed to Assistant Commissioner for Trade-
marks, 2900 Crystal Drive, Arlington, VA 22202-3513.

on 01-07-03

Nancy M. Grams
(SIGNATURE)
NANCY M. GRAMS

L:\NMG\GREG\POQBRIEF.WPD

January 7, 2003

Cu

TABLE OF CONTENTS

I.	INTRODUCTION.....	5
II.	ISSUES OF THESE PROCEEDINGS.....	5
III.	THE DESCRIPTION OF THE RECORD.....	5
IV.	OPPOSER HAS PRIORITY RIGHTS OVER APPLICANT.....	15
V.	THERE IS A LIKELIHOOD OF CONFUSION.....	17
	A. THE SERVICES ARE IDENTICAL.....	18
	B. THE TRADE CHANNELS ARE IDENTICAL.....	21
	C. THE SERVICES INVOLVED ARE NOT PURCHASED WITH CARE OR CONSIDERATION.....	22
	D. THE CLASS OF CONSUMER IS IDENTICAL AND IS NOT SOPHISTICATED.....	22
	E. UNA MAS IS SIMILAR TO POQUITO MAS IN SIGHT, SOUND, MEANING, AND COMMERCIAL IMPRESSION	23
	F. THE FAME OF OPPOSER'S MARKS.....	29
	G. ACTUAL CONFUSION EXISTS.....	31
	H. THE EXTENT OF POTENTIAL CONFUSION.....	33
VI.	SUMMARY OF LIKELIHOOD OF CONFUSION.....	34
VII.	CONCLUSION.....	37
VIII.	RELIEF REQUESTED.....	37

TABLE OF CASES

Burger Chef Systems, Inc. v. Burger Man, Inc., 181 USPQ 168 (C.C.P.A. 1974);

Café Licensing Corp. v. Elsea, 48 USPQ 2d 1400 (T.T.A.B. 1998);

Canadian Imperial Bank v. Wells Fargo Bank, 1 USPQ 2d 1813 (C.A.F.C. 1987);

Carl Karcher Enterprises, Inc. v. Stars Restaurants, Corp., 35 USPQ 2d 1125 (T.T.A.B. 1995);

Century 21 Real Estate Corp. v. Century Life of America, 23 USPQ2d 1698 (C.A.F.C. 1992);

In re Comexa Ltd., 60 USPQ2d 1118 at 1120 (T.T.A.B. 2001);

Commerce Drug Co. v. Kirkman Lab., Inc., 174 USPQ 265 (C.C.P.A. 1972);

Cunningham v. Laser Golf Corp., 55 USPQ 2d 1842 (C.A.F.C. 2000);

In re Dixie Restaurants, Inc., 41 USPQ 2d 1531 (C.A.F.C. 1997);

In re E.I. DuPont de Nemours & Co., 177 USPQ 563 (CCPA 1973);

Giant Food, Inc v. Nation's Foodservice, Inc., 218 USPQ 390 (C.A.F.C. 1983);

I.C. Hall Company v. Hallmark Cards, Inc., 144 USPQ 435 (CCPA 1965);

Hard Rock Café Licensing Corp. v. Elsea, 48 USPQ 2d 1400 (T.T.A.B. 1998);

Hard Rock Café Licensing Corp. v. Elsea, 56 USPQ 2d 1504 (T.T.A.B. 2000);

J & J Snack Foods Corp. v. McDonald's Cor., 18 USPQ 1889, 1892 (Fed. Cir. 1991);

In re Lamson Oil Company, 6 USPQ2d 1041, (TTAB 1987);

J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*,
Section 23:36, pg. 23-116;

Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L., 49 USPQ2d 2018 (T.T.A.B 1998);

Molenaar. Inc. v. Happy Toys, Inc., 188 USPQ 469 (TTAB 1975);

Octocom Systems, Inc. v. Houston Computers Services, Inc., 16 USPQ 2d 1783 (C.A.F.C. 1990);

Planter's Nut & Chocolate Company v. Crown Nut Company, Inc., 134 USPQ 504 (CCPA 1962);

Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 223 USPQ 1281 (C.A.F.C. 1984);

Spice Islands, Inc. v. Frank Tea and Spice Company, 184 USPQ 35 (CCPA 1974);

Spoons Restaurants, Inc. v. Morrison, Inc., 23 USPQ2d 1735 (TTAB 1991);

Toys 'R Us, Inc. v. Lamps 'R Us, 219 USPQ 340 (TTAB 1983);

Trademark Manual of Examining Procedure Section 1207.01(a)(iii);

Two Pesos, Inc. v. Taco Cabana, Inc., 23 USPQ2d 1081 (1992).

I. INTRODUCTION

Kevin T. McCarney, dba Poquito Mas (hereinafter "Opposer"), in the above-referenced combined opposition against Una Mas, Inc. (hereinafter "Applicant"), requests that Opposer's Notices of Opposition be sustained and that applications Serial No. 75/214,266 (hereinafter "'266 application'") and 75/154,590 (hereinafter "'590 application'") (collectively "Subject Applications") be denied and that no registration be issued.

The '266 application and '590 application include "UNA MAS" and are barred from registration under 15 U.S.C. § 1052(d), as each is confusingly similar to Opposer's previously used trademarks for POQUITO MAS. In support of this Brief are several Notices of Reliance which include Opposer's valid and subsisting registrations on the Principal Register and the Testimony of Kevin T. McCarney (hereinafter "McCarney Testimony") which includes several supporting exhibits. The facts and laws supporting such judgment are set forth below.

II. ISSUES OF THESE PROCEEDINGS

Whether Opposer has priority rights in Opposer's marks over Applicant's rights in the marks of Subject Applications.

Whether there is a likelihood of confusion between Subject Applications and Opposer's marks.

III. THE DESCRIPTION OF THE RECORD

Opposer has introduced 7 notices of reliance (designated ONOR1 through ONOR 7).

ONOR 1 includes Title and Status copies of Opposer's registrations.

ONOR 2 includes Dictionary definitions for the words "little" and "one"

ONOR 3 includes Lexis/Nexus printouts of articles referencing either Applicant or Opposer.

ONOR 4 includes Applicant's responses to Opposer's discovery requests.

ONOR 5 includes publications involving Opposer.

ONOR 6 includes a file history for Application S.N. 76/262,751 for the mark THE MAS.

ONOR 7 includes documents received from Applicant.

Opposer has introduced the testimony of Kevin T. McCarney along with several testimony exhibits (McCarney Testimony).

Opposer has also referenced Applicant's testimony of Richard Hamner including several testimony exhibits (Hamner Testimony).

Opposer is the owner of the trademark POQUITO MAS and has previously and continuously used this mark, without abandonment, since 1984 for its restaurant services. (McCarney Testimony, 11, 25; 12, 1-6; 14, 8-12). In this respect, Opposer is the owner and proprietor of a chain of restaurants named POQUITO MAS and has been offering restaurant services to the consuming public under the POQUITO MAS trademark since 1984. (McCarney Testimony). Opposer continues to expand its restaurant services provided under the POQUITO MAS marks. (McCarney Testimony, 14, 12-25; 15, 1-11, Exh. 1, 2). Opposer uses its POQUITO MAS marks in the advertising of its restaurant services and in the sale of Mexican food products in its restaurants to identify its restaurant services. (McCarney Testimony 60, 12-25; 61, 1-16, Exh. 4-9, 11, 14, 15, 25, 26).

Today, the POQUITO MAS service mark is used in Southern California, namely, Los Angeles, in connection with restaurant services on a number of different Mexican-style food and

beverage items. (McCarney Testimony 10, 6-8, Exh. 5, 6 and 11). Through Opposer and substantial word-of-mouth promotion and advertisements, Opposer's POQUITO MAS marks have become well known. Opposer's restaurants are classified as a taquaria or fast-casual Mexican restaurants based on its casual atmosphere and quick service. (ONOR 3, Att. 2 and 5 Att. 11).

Several restaurant critics have written about and recognized Opposer's restaurant services sold under the POQUITO MAS mark. (McCarney Testimony 99, 25-26; 100). Restaurant critic, Michelle Huneven, from the Los Angeles Times who originally described POQUITO MAS as "a 'little more' than a 'Mexican fast-food joint,'" went on to write several years latter that she has become "a Poquito Mas fan" and that "sometimes, nothing will do but the San Felipe shrimp tacos...." (ONOR 5, Att. 2). Another restaurant critic, Larry Lipson who has for many years titled his discussions concerning Opposer "A little more, senior.", ranked POQUITO MAS as the "Best of the Valley" for its outstanding food (ONOR 5, Att. 1). Merrill Shindler in a 1993 article wrote that while "Poquito Mas looks, on the surface, like any number of small taquerias... this is food that definitely stands out from the crowd." (ONOR 5, Att. 5). Jean T. Barrett writes "[w]hen I don't have all evening to savor a Mexican meal, I make a beeline for Poquito Mas, a small chain of taco stands...'The Mas,' as it is known around our house, serves terrific freshly prepared....." (ONOR 5, Att. 6 and McCarney Testimony Exh. 33). Another article in Westways, when describing POQUITO MAS states "[t]he prices befit a fast-food joint, but the food itself would shine in a white-tablecloth restaurant. Cheap eats." (ONOR 5, Att. 7). An article in the Daily Variety entitled "Top Chefs Know Where to Go for Good Grub," and talks about a well-known cook Michael Rosen who prepared food at a fundraiser for President Clinton, dines at POQUITO MAS for "quickie fast food

stuff.” (ONOR 5, Att. 8). An author of an article in the Los Angeles Times writes “I have come to require semi-regular doses of Poquito Mas’ grilled shrimp tacos...[in] fact, just about everything in this upscale taco stand is as good as it gets....” (ONOR 5, Att. 9). In 1997, POQUITO MAS made the “ELMER RECOMMENDS” list for restaurant standouts. (ONOR 5, Att. 10). The author of the Valley Weekend Calendar of the Los Angeles Times writes that “[e]verything is first-rate at Poquito Mas.” (ONOR 5, Att. 11). These articles show the type of restaurant services provided by Opposer and that Opposer’s POQUITO MAS mark is well known and is known to represent a chain of restaurants that sell quality Mexican-style food that compete with fast-food restaurants. Over 18 years of favorable reviews, word-of-mouth advertisements and other promotions have made Opposer’s POQUITO MAS marks very strong for its restaurant services.

Opposer is the owner of United States Trademark Registration No. 1,892,451 for POQUITO MAS which recites “restaurant services,” in International Class 42. (ONOR 1, Att. 3) (hereinafter “the ‘451 registration”). The ‘451 registration was filed on December 13, 1993, registered on May 2, 1995, and is incontestable. Opposer is also the owner of United States Trademark Registration No. 2,026,811 for POQUITO MAS THE ORIGINAL BAJA TACO STAND & Design which recites “restaurant services,” in International Class 42. (ONOR 1, Att. 2) (hereinafter “the ‘811 registration”). The ‘811 registration was filed on November 13, 1995 and registered on December 31, 1996. Opposer is the owner of United States Trademark Registration No. 2,212,685 for POQUITO MAS THE ORIGINAL BAJA TACO STAND & Design which recites “restaurant services,” in International Class 42. (ONOR 1, Att. 1) (hereinafter “the ‘685 registration”). The ‘811 registration was filed on September 22, 1997 and registered on December 22, 1998.

Applicant operates a chain of Mexican restaurants in northern California using the UNA MAS name. (McCarney Testimony 20, 8-11, Exh. 10 and 28). Applicant, in these restaurants, offers inexpensive Mexican-style food items in a fast-casual type of setting. (Hamner Testimony 35, 23-24 and ONOR 4, Att. 1 Resp. 3). Applicant first used the UNA MAS mark in September 1991. (The '266 application and Hamner Testimony 7, 12-13). Applicant has admitted that there is no use of any of its UNA MAS marks prior to 1991 (ONOR 4, Att. 2 Resp. 14). In fact, Applicant's own web page (www.unamas.com), states that the UNA MAS restaurant was, "Pioneered in 1991." (McCarney Testimony, Exh. 29).

Applicant filed an application to register UNA MAS, Serial No. 75/214,266, on December 17, 1996 which is subject to these proceedings. The '266 application recites "restaurant services," in International Class 42. Applicant filed a second application to register ONE IS GOOD, BUT UNA MAS IS BETTER, Serial No. 75/154,590, on August 22, 1996 which is also subject to these proceedings (hereinafter "the '590 application"). The '590 Application recites "restaurant services," in International Class 42. The '266 & '590 applications set forth a first use date of September 1991 and May 28, 1996, respectively.

On June 9, 1997, Opposer filed Opposition No. 107,748 against Application Serial No. 75/154,590 for ONE IS GOOD, BUT UNA MAS IS BETTER and Opposition No. 107,026 against Application Serial No. 75/214,266 for UNA MAS. On March 27, 1998, the Board granted Opposer's Motion to Consolidate Opposition Nos. 107,026 and 107,748.

Opposer's registrations and Applicant's applications which are subject to these proceedings all recite "restaurant services," in International Class 42. Furthermore, based on actual use, Opposer

and Applicant provide identical restaurant services. In fact, Opposer and Applicant would be in direct competition with one another if they were in the same geographic location. (McCarney Testimony, 97, 7-14, and Exh. 27, opposer's menu; and Hamner Testimony Exh. 2). Opposer's and Applicant's restaurant services both involve Mexican-style food. (Id.). Both Opposer and Applicant provide restaurant services which are classified as "fast-casual" and directly compete with fast-food restaurants. (McCarney Testimony, 10, 7-8, 18-25; Hamner Testimony 9, 1-2, 17, 18-20 and ONOR 4, Att. 1 Resp. 3). In fact, both parties of these proceedings and 3rd parties describe Opposer's and Applicant's restaurants services as "fast-casual" or "taquerias." (ONOR 3, Att. 2 and 8; ONOR 5, Att. 4, 5 and 11).

Turning to the menus of Opposer and Applicant (McCarney Testimony, Exh. 26 and 27, and Applicant's specimens for the '590 and '266 applications), the similarities go well beyond the fact that both parties specialize in fast-casual, Mexican style food. Initially both parties offer meals for about \$5.00. Both parties offer similar fresh Mexican-style food at fast-food prices. The food is prepared to order using only fresh and natural ingredients. Both parties make the same statement that their food is made fresh and contains no lard and no MSG. Both parties offer dinner plates or platos having charbroiled or grilled chicken, steak or pork, each within a few pennies of the \$5.00 price range. Both parties serve as feature portions of their respective menus burritos, tacos, nachos and quesadillas. Furthermore, the flavor options under each of these headings are virtually identical, as are the prices. Both parties provide a "Kid's Meal" section in their menu, and each of the menus includes a beverage called a "horchata." Finally, each of the menus refer to catering or party packs. The comparison between the menus alone shows that Opposer and Applicant provide virtually

identical Mexican-style food at fast-food prices and provide a level of dining that competes with fast food dining wherein the food is fresh and natural.

As can also be seen from a comparison of Opposer's and Applicant's web sites (McCarney Testimony, Exh. 10 and 11), Applicant offers its taqueria-style restaurant services in a setting that is virtually identical to Opposer. Both restaurants prepare their Mexican-style food to order and both claim to fill a void between fast food outlets and full service dining establishments. Both restaurants utilize an informal dining atmosphere.

A review of the trade dress of the restaurants shows additional similarities. While trade dress is not an issue before the Board, Applicant's use of a virtually identical trade dress as is used by Opposer, is further evidence that the UNA MAS mark projects a confusingly similar commercial impression and that a likelihood of confusion exists. A comparison of the interior of Opposer's restaurants and Applicant's newly remodeled restaurant shows that there are many similarities. (McCarney Testimony 22, 1-11; and Exh. 14 and 15 - Opposer's restaurant, and Exh. 19-23 - Applicant's restaurant). First, the interior walls of Applicant's restaurant are painted an extremely similar light yellow color as Opposer's interior walls. (McCarney Testimony 24, 23-25 and Exh. 14, 15 and 19-23). Second, the seating used by Applicant is very similar to the seating used by Opposer. In this respect, Applicant's booths are a very dark burgundy with light blonde wood trim which have the same commercial impression as Opposer's booths. (McCarney Testimony 25, 21-23, 27, 8-10 and Exh. 14, 15 and 19-23). Applicant's chairs are also made of a light blonde wood which are similar to Opposer's light blonde wood chairs. (McCarney Testimony 25, 23-24, 26, 24-27, 2, 27, 13-16 and Exh. 14, 15 and 19-23). Third, the light blonde wood trim in the remaining portions of

Applicant's restaurant is similar to the light blonde wood trim in Opposer's restaurant. (McCarney Testimony 26, 20-23, 27, 13-16 and Exh. 14, 15 and 19-23). Fourth, yet another similarity is the smooth cement floors used in both eating establishments. (McCarney Testimony 26, 16-19 and Exh. 14, 15 and 19-23). As a result of these and other similarities, the overall appearance of Applicant's restaurant is very similar to that of Opposer's restaurant.

Turning to the marks themselves and particularly to POQUITO MAS and UNA MAS, both marks include two words having clear Spanish origin. A literal English translation of POQUITO MAS is "little more" and a literal English translation of UNA MAS is "one more." (ONOR 1, Att. 1-3; '266 and '590 applications). Applicant, during prosecution of the subject application, affirmatively stated that the English translation of UNA MAS is "one more." (the '266 and '509 applications). Opposer, during prosecution of its applications, which have matured into the registrations cited in these proceedings, affirmatively stated that the English translation of POQUITO MAS is "little more." (ONOR 1, Att. 1-3).

The phrases "little more" and "one more" are essentially the same, especially when it relates to food being served in restaurants. Often, a person will request "a little more of this," or "one more of that." A restaurant can provide a little more food, a little more atmosphere and/or a little more service. (McCarney Testimony 75, 21-25 and 76, 1). Turning to the dictionary definitions of "little" and "more," "little" means "a small amount" or "in only a small quantity." (ONOR 2, Att. 1). The word "one" refers to "being a single unit or thing." (ONOR 2, Att. 2). In other words, "one" is a small amount or quantity. Thus, "little more" or POQUITO MAS broadly defines and encompasses the phrase "one more," or UNA MAS.

The consumer of Opposer's and Applicant's services at least generally recognizes the English equivalent of both POQUITO MAS and UNA MAS. Many of the articles which relate to either Opposer's or Applicant's restaurants include the author's recognition of the translated meaning of the marks. For example, the author of the Daily Herald states "The restaurant - whose name means 'one more' - is popular in..." (ONOR 3, Att. 6). The author from The Washington Post writes "At Una Mas! (in Spanish it means 'one more'), California native..." (ONOR 3, Att. 7). In the Pittsburgh Post-Gazette it reads "At Una Mas! (Spanish for 'one more')..." (ONOR 3, Att. 10). The author of the Nation's Restaurant News writes "Richard Hamner can't resist the urge to open Una Mas! ('One More!')" (ONOR 3, Att. 13). In The San Francisco Chronicle it reads "Started in San Jose not quite six years ago, Una Mas (meaning, one more) has been...." (ONOR 3, Att. 14). With respect to Opposer POQUITO MAS mark, a restaurant critic Larry Lipson has titled his discussion of POQUITO MAS as "A little more, senor" for many years (ONOR 3, Att 15-31). Another restaurant critic, Michelle Huneven, in the Los Angeles Times writes "while Poquito Mas is indeed a Mexican fast-food joint, it's also a little more, or rather, un poquito mas, than that." (ONOR 5, Att 3).

Turning to the parties and the "more" concept, both flaunt or draw attention to the general idea of "more." Applicant's own mark, which is subject to these proceedings, puts forth the idea of "more." In this respect, the slogan ONE IS GOOD, BUT UNA MAS IS BETTER of the '590 Application, is a takeoff of the phrase "if one is good, two is better" by replacing "two" with the phrase "BUT UNA MAS." Applicant's menu, which is the specimen for the applications of these proceedings, includes "[f]resh fiesta flavors to keep you fit for life. And always good enough to say Una Mas!" Applicant's own CEO, Angela Pace, repeatedly puts forth the general "more" concept.

In an April 2001 article, Ms. Pace states that Una Mas "deliver[s] on [its] promise of providing more of what our guest really want... giving our guests what they really want with a few more authentic surprises." (ONOR 3, Att. 1). In a June 25, 2001 article, Ms. Pace is quoted as saying some changes to the restaurant are "all part of delivering more of what our guests want." (ONOR 3, Att. 9). The web site operated by Applicant includes reference to the "more" concept with, among other things, the inclusion of the phrase "Get More of What You Really Want" set out by itself in an emblazon fashion. (McCarney Testimony Exh. 29). One of Applicant's advertisements is replete with reference to the general "more" concept. The advertisement includes as it's primary text the lead off statement ONE IS GOOD, BUT UNA MAS IS BETTER. Then the advertisement puts forth:

"More of a good thing is always better. That's why UNA MAS! always gives you more for your money. More taste. More flavors. More freshness. And of course more food. So look over the great offers, because after you try us once, you're bound to be back for UNA MAS!"

(McCarney Testimony Exh. 13). The front of Applicant's menu includes the statement "Get more of what you really want!" (McCarney Testimony Exh. 28). Applicant's use of the "more" concept is virtually identical to Opposer's use of the "more" concept. This use relates generally to giving more to the consumer. Not just one more, but more in general. Opposer has a web page on its web site with the title "A Little More About The Mas." (McCarney Testimony Exh. 11). The web page also includes "We always give you a little more than anyone else." (McCarney Testimony Exh. 11). Opposer's original menu includes the phrase "Mexican Food with 'a little more'." (McCarney Testimony Exh. 5). While the definition of "little more" and "one more" have minor differences, the general meaning is virtually identical, the use by Applicant and Opposer is virtually identical and the consumer impression is identical.

Even with the current geographic separation between Opposer and Applicant, incidences of have occurred. (McCarney Testimony 95-98 and Exh. 42). One such occurrence took place when Kevin McCarney was in route to San Francisco several years ago. While on the airplane, McCarney had a conversation with the passenger next to him. In their discussion, McCarney indicated that he owned and operated a string of Mexican-style restaurants called POQUITO MAS. At that point, the passenger remarked, "Oh, the UNA MAS chain up here." (McCarney Testimony 96, 10-11). In a separate trip north of Los Angeles, McCarney witnessed another incident of actual consumer confusion. While in Los Gatos, McCarney informed a cashier of his profession and the POQUITO MAS restaurants. The cashier's immediately asked whether McCarney's restaurants is related to UNA MAS. (McCarney Testimony 97, Exh. 2-3).

Finally, both parties have put forth a clear desire to expand its respective chain of restaurants. (McCarney Testimony 14, 15-25, and 15, 1-11, and Exh. 10). As can be seen from the Una Mas menu and Applicant's web page, Applicant is currently expanding and lists 11 new locations which are "opening soon." (McCarney Testimony 14, 15-25, and 15, 1-11; Exh. 10; '266 and '590 applications). The web page states that Applicant plans 80 operational units by 1999. In addition, Applicant has merged with another chain named Pollo Rey and has plans to open many new restaurants under the UNA MAS name (ONOR 7, Att. 2). These restaurants would be located all along the West Coast of California and other western states.

IV. OPPOSER HAS PRIORITY RIGHTS OVER APPLICANT

The rights to a trademark stem from prior appropriation and use. Under 15 U.S.C. §1051(a), the owner of a trademark used in commerce may apply to register the trademark under the Lanham

Act. Registration simply provides for the preservation of the existing right in a trademark. It does not create the right. Opposer first used its POQUITO MAS mark in commerce in 1984 for its restaurant services, has continuously used its POQUITO MAS mark since 1984 and continues to use its POQUITO MAS marks today. Opposer also continues to expand its restaurant services provided under its POQUITO MAS marks. (McCarney Testimony 14, 15-25 and 15, 1-11). Opposer has continuously used its POQUITO MAS marks in advertising of its restaurant services and in the sale of Mexican food products in its restaurants to identify its restaurant services. (McCarney Testimony 14, 15-25 and 15, 1-11).

Opposer is the owner of the '685 Registration, the '811 Registration and the '451 Registration. (ONOR 1, Att. 1, 2 and 3, respectively). The '451 registration is for the service mark POQUITO MAS and recites "restaurant services." The first use date of the '451 registration is October 1984. (ONOR Att 3). The '685 and '811 Registrations are for POQUITO MAS THE ORIGINAL BAJA TACO STAND & Design and recite "restaurant services." (ONOR 1, Att. 1 and 2, respectively). These registrations evidence that Opposer has the exclusive right to use the registered marks in commerce on or in connection with its restaurant services enumerated in the registration. 15 U.S.C. § 1115(a). The registration of a mark on the Principal Register is *prima facie* evidence of the Opposer's continuing use of the mark, such use dating back to the filing date of the application. J.C. Hall Company v. Hallmark Cards, Inc., 144 USPQ 435 (CCPA 1965). The '451 and '811 Registrations are incontestable.

Applicant filed the '590 application for ONE IS GOOD, BUT UNA MAS IS BETTER on August 22, 1996 and the '266 application for UNA MAS on December 17, 1996. The '590

application and the '266 application set forth a first use date of May 28, 1996 and September 1991, respectively. Applicant has admitted that there is no use of any of its UNA MAS marks prior to 1990 (ONOR 4, Att. 2, Resp. 14). In fact, Applicant's own web page (www.unamas.com) states that the Una Mas restaurant was "Pioneered in 1991." (McCarney Testimony, Exh. 10).

For all the above reasons, Opposer has priority. Opposer has used its POQUITO MAS trademark long prior to the filing and/or first use date by Applicant for the marks of the '590 application and the '266 application and Applicant has admitted the same.

V. THERE IS A LIKELIHOOD OF CONFUSION

Under the Lanham Act, 15 U.S.C. § 1052(d), a trademark shall be refused for registration on the Principal Register if the mark:

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive...

The factors used to determine likelihood of confusion are set in In re E.I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors most relevant in these proceedings are as follows:

- (1) The services are identical;
- (2) The trade channels are identical;
- (3) The services involved are not purchased with care or consideration;
- (4) The class of consumer is identical and is not sophisticated;

(5) UNA MAS is similar to POQUITO MAS in sight, sound, meaning and commercial impression;

(6) The fame of Opposer's marks;

(7) Incidences of actual confusion exist; and

(8) The extent of potential confusion.

When these factors, which will be discussed in detail below, are view together, it shows that there is a likelihood of confusion between Applicant's UNA MAS marks and Opposer's POQUITO MAS marks.

A. THE SERVICES ARE IDENTICAL

Opposer's registrations and Applicant's applications which are subject to these proceedings recite "restaurant services." Accordingly, as far as these proceedings are concerned, the services are to be considered identical for the analysis of whether a likelihood of confusion exists. Cunningham v. Laser Golf Corp., 55 USPQ 2d 1842 at 1848 (C.A.F.C. 2000); citing Canadian Imperial Bank v. Wells Fargo Bank, 1 USPQ 2d 1813 at 1815 (C.A.F.C. 1987); In re Dixie Restaurants, Inc., 41 USPQ 2d 1531 at 1534 (C.A.F.C. 1997); and Commerce Drug Co. v. Kirkman Lab., Inc., 174 USPQ 265 at 267 (C.C.P.A. 1972). Trademark Manual of Examining Procedure Section 1207.01(a)(iii).

Even if the actual services provided by Opposer and Applicant are considered, they are still identical, and Opposer and Applicant would be in direct competition with each other if they were in the same geographic location. In this respect, Opposer's restaurant services involve Mexican-style food. (McCarney Testimony 10, 6-8 and Exh. 25-27). Applicant's restaurant services involve Mexican-style food. (ONOR 4, Att 1, Resp. 3). Turning to the menus of Opposer and Applicant

(McCarney Testimony, Exh. 25-27 for Opposer and the specimen for both the '590 and '266 applications), the similarities go well beyond the fact that both parties specialize in Mexican-style food. The parties also offer the exact same style of Mexican food. Both parties offer fresh Mexican-style food at fast-food prices. (See menus). Both parties and third parties describe Opposer's and Applicant's restaurants as "fast-casual" or "taquerias." (ONOR 3, Att. 2; ONOR 4, Att. 1, Resp. 3; and ONOR 5, Att. 11). Both restaurants offer dinner plates or platos having charbroiled or grilled chicken, steak or pork, each in the \$5.00 price range. Both parties serve as feature portions of their respective menus burritos, tacos, nachos and quesadillas. Furthermore, the flavor options under each of these headings are virtually identical. Both parties provide a "Kid's Meal" section in their menu, and each of the menus include a beverage called a "horchata." Finally, both parties' restaurants offer catering and party packs. The comparison between the menus show that Opposer and Applicant provide virtually identical Mexican-style food at fast-food prices and provide a level of dining that competes with fast-food dining wherein the food is fresh and natural. Both Opposer and Applicant also try to fill the void between Mexican fast-food and the food provided by full service restaurants (McCarney Testimony 11, 11-22 and ONOR 7, Att. 7).

Applicant offers its taquaria or fast-casual style restaurant services in a setting that is virtually identical to Opposer. Both Opposer's and Applicant's restaurants prepare their Mexican-style food fresh and to order, however, neither provide table service by a waiter or waitress. (McCarney Testimony 10, 20-25 and Hamner Testimony 17, 14-25). Both restaurants utilize an informal dining atmosphere. Furthermore, the informal dining atmosphere is virtually identical. In this respect, Applicant's newly remodeled restaurant includes many similarities to Opposer's interior design.

(McCarney Testimony 22, 1-11; Exh. 14 and 15 - Opposer's restaurant, and Exh. 19-23 - Applicant's restaurant). One similarity relates to the color choice of the interior walls. Applicant has chosen a light yellow for its walls which is very similar to Opposer's interior wall color. (McCarney Testimony Exh. 24, 23-25 and Exh. 14, 15 and 19-23). Applicant has also chosen seating which is very similar to the seating used by Opposer. Applicant's booths are a very dark burgundy with light blonde wood trim which are very similar to the booths used by Opposer and which have the same commercial impression as Opposer's booths. (McCarney Testimony 25, 21-23; 27, 8-10 and Exh. 14, 15 and 19-23). The remaining chairs used by Applicant are made of a light blonde wood which is very similar to Opposer's light blonde wood chairs. (McCarney Testimony 25, 23-24; 26, 24 to 27, 2; 27, 13-16 and Exh. 14, 15 and 19-23). Turning to the trim used by Applicant, it is also made from light blonde wood and is very similar to the use of light blonde wood trim in Opposer's restaurant. (McCarney Testimony 26, 20-23; 27, 13-16 and Exh. 14, 15 and 19-23). Applicant also uses a smooth cement floor which is similar to the smooth cement floor used by Opposer. (McCarney Testimony 26, 16-19 and Exh. 14, 15 and 19-23). As a result of these and other similarities, the overall appearance and commercial impression of Applicant's restaurant is very similar to that of Opposer's restaurant. Indeed, it could be said that Applicant has copied Opposer's trade dress in its restaurant concept. While trade dress is not an issue before the Board, the Applicant's use of a virtually identical trade dress as used by Opposer, is further evidence that the UNA MAS mark projects a confusingly similar commercial impression and that a likelihood of confusion exists. Two Pesos, Inc. v. Taco Cabana, Inc., 23 USPQ2d 1081 (1992). Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 223 USPQ 1281, 1284 (Fed. Cir. 1984).

Opposer submits, that no matter what method of comparison is used (actual or recited services), Applicant provides the identical services as Opposer and in fact would be in direct competition with Opposer if both parties operated in the same geographic location.

B. THE TRADE CHANNELS ARE IDENTICAL

As stated above, Opposer's registrations and Applicant's applications recite "restaurant services." Neither Opposer nor Applicant in its respective registrations or applications restricted its restaurant services and, therefore, as far as these proceedings are concerned, the trade channels are to be considered identical for the analysis of whether a likelihood of confusion exists. Cunningham v. Laser Golf Corp., 55 USPQ 2d 1842 at 1848 (C.A.F.C. 2000); Hard Rock Café Licensing Corp. v. Elsea, 48 USPQ 2d 1400 (T.T.A.B. 1998); and Octocom Systems, Inc. v. Houston Computers Services, Inc., 16 USPQ 2d 1783 (C.A.F.C. 1990).

As with the services discussed above, the actual trade channels, except for geographic differences, are also identical. Both Opposer and Applicant provide fresh Mexican-style cuisine to retail customers for about \$5.00 per meal. (Opposer's and Applicant's menus; McCarney Testimony Exh. 26; and Hamner Exh. 4, respectively). In fact, Opposer and Applicant are in competition for the same retail consumers, namely, a restaurant patron looking for inexpensive Mexican food which is served fast like fast food, but which is served to order utilizing fresh ingredients. Both Opposer and Applicant put forth an image of providing fresh, authentic Mexican-style food which is prepared to order on the premises with only fresh and healthy ingredients which do not include preservatives. (McCarney Testimony Exh. 11 and 30).

C. THE SERVICES INVOLVED ARE NOT PURCHASED WITH CARE OR CONSIDERATION

As is discussed above, Opposer's registrations and Applicant's applications recite "restaurant services" which include the highly competitive fast-food restaurants services. In addition, based on actual use, both Opposer and Applicant offer inexpensive Mexican-style food, wherein entrees are priced in the \$5.00 range or below. Both parties compete with fast-food chains for the same consumer. This type of service, namely, inexpensive restaurant service, is purchased casually, is subject to quick consumption and is subject to a lesser standard of purchasing care. Spoons Restaurants, Inc. v. Morrison, Inc., 23 USPQ2d 1735, 1741 (TTAB 1991); Special Brand at 1288; Spice Islands, Inc. v. Frank Tea and Spice Company, 184 USPQ 35 (CCPA 1974). The Board in Carl Karcher Enterprises, Inc. v. Stars Restaurants, Corp., went further to state that "the purchase of fast foods often is made on impulse." 35 USPQ 2d 1125 at 1129 (T.T.A.B. 1995). Furthermore, the selection of fast-food type restaurant services is often done on the "*basis of casual recollection of what they may have experienced in other places at other times.*" Id. At 1129, [emphasis added] quoting Burger Chef Systems, Inc. v. Burger Man, Inc., 181 USPQ 168 at 169 (C.C.P.A. 1974). In Burger Chef, the Board went on to state that since the restaurant services are relatively inexpensive, "[t]hese facts weigh in favor of a finding of likelihood of confusion. citing Burger Chef, at 169.

D. THE CLASS OF CONSUMER IS IDENTICAL AND IS NOT SOPHISTICATED

Again, both Opposer's registrations and Applicant's applications recite "restaurant services" which include the highly competitive fast-food restaurants services. In addition, based on actual use, both Opposer and Applicant offer inexpensive Mexican-style food, wherein entrees are priced in the five dollar range. There is nothing in the record that indicates anything other than the fact that both

Opposer's and Applicant's restaurant services are offered to the general public. Indeed, the record shows that both parties offer their respective services to the general public and logic confirms the same. A typical consumer of restaurant services, especially ones that compete in the fast-food category, is any passerby with an appetite, namely, the general public. In re Comexa Ltd., 60 USPQ2d 1118 at 1120 (T.T.A.B. 2001). Furthermore, the services offered by Opposer and Applicant are inexpensive. Accordingly the consumer for these proceedings cannot be considered sophisticated which further supports that a likelihood of confusion exists. Id. at 1120.

E. UNA MAS IS SIMILAR TO POQUITO MAS IN SIGHT, SOUND, MEANING AND COMMERCIAL IMPRESSION

As an initial matter, in view of the facts that the services are identical, the trade channels are identical, the class of consumer are identical and are not sophisticated, and that the purchase of these services are often done on impulse, "the degree of similarity necessary to support a conclusion of likely confusion declines." In re Dixie Restaurants, Inc., 41 USPQ2d 1531 at 1534 (C.A.F.C. 1997), citing Century 21 Real Estate Corp. v. Century Life of America, 23 USPQ2d 1698 at 1701 (C.A.F.C. 1992). Furthermore, it is well established that it is not whether the marks are distinguishable in a side-by-side comparison, it is whether based on the average purchaser's recollection. In re Continental Graphics Corp., 52 USPQ2d 1374 at 1375 (T.T.A.B. 1999); citing Sealed Air Corp. v. Scott Paper Co., 190 USPQ 1374 (T.T.A.B. 1975). The basis for the analysis should be based on how the marks are used and how they are observed by the consumer. Carl Karcher Ent., at 1130. Marks used in connection with restaurant services are not viewed by side-by-side comparison. Id. These marks are viewed by the average consumer at different places and at different times. Only in the unlikely situation that the restaurants were built next to one another would there be a chance of

such a comparison. Nonetheless, evaluation of the similarities between POQUITO MAS and UNA MAS shows that there are substantial similarities in each of the elements of appearance, sound, meaning, and commercial impression. Similarity in any one of the elements of appearance, sound or meaning is sufficient to support a likelihood of confusion. In re Lamson Oil Company, 6 USPQ2d 1041, 1042 (TTAB 1987).

With respect to sight and sound, POQUITO MAS and UNA MAS have several similarities. Both marks include two separate words. The two words in each mark are Spanish words which have a clear Spanish origin. In this respect, while some foreign words may not clearly reveal their origin, the words involved in this analysis have clear Spanish connections. This in view of the use by both Opposer and Applicant in connection with Mexican-style food will clearly convey the Spanish origin to the consumer of these services. In addition, both marks contain the same last word, namely, "MAS."

Turning to the similarities in meaning and commercial impression, POQUITO MAS and UNA MAS are virtually identical. A literal English translation of POQUITO MAS is "little more." A literal English translation of UNA MAS is "one more." Applicant, during prosecution of the '266 and '590 applications, affirmatively stated that the English translation of UNA MAS is "one more." Opposer, during prosecution of its applications which have matured into the registrations of these proceedings, affirmatively stated that the English translation of POQUITO MAS is "little more." (ONOR 1, Att. 1-3). The phrases "little more" and "one more" mean essentially the same thing, especially when it relates to food being served in restaurants. In fact, the definition of the word "little" include "one." (ONOR 2, Att. 1 and 2). In this respect, "little" means "a small amount" or

"in only a small quantity." The word "one," refers to "being a single unit or thing." In other words, "one" is a small amount or quantity. Thus, "little more" for POQUITO MAS broadly defines and encompasses the phrase "one more," i.e. UNA MAS.

In fact, both parties flaunt or draw attention to the general idea of providing "more." Turning to Applicant and its use of the "more" concept, the '590 application is the slogan ONE IS GOOD, BUT UNA MAS IS BETTER. This slogan is a takeoff of the phrase "If one is good, two is better" wherein Applicant uses the phrase "BUT UNA MAS" as a replacement for TWO. Applicant's menu, which is the specimen for the applications of these proceedings, includes "[f]resh fiesta flavors to keep you fit for life. And always good enough to say Una Mas!" Applicant's own CEO Angela Pace repeatedly puts forth the general "more" concept. For example, in an April 2001 article, Ms. Pace states that Una Mas "deliver[s] on [its] promise of providing more of what our guests really want...giving our guests what they really want with a few more authentic surprises." (ONOR 3, Att. 1). In a June 25, 2001 article, Ms. Pace is quoted as saying some changes to the restaurant are "all part of delivering more of what our guests want." (ONOR 3, Att. 9). The web site operated by Applicant includes the phrase "Get More of What You Really Want" set out by itself in an emblazon manner. (McCarney Testimony Exh. 29). One of Applicant's advertisements is replete with reference to the general "more" concept. The advertisement includes as its primary text the lead off statement ONE IS GOOD, BUT UNA MAS IS BETTER. Then the advertisement puts forth:

"More of a good thing is always better. That's why UNA MAS! always gives you more for your money. More taste. More flavors. More freshness. And of course more food. So look over the great offers, because after you try us once, you're bound to be back for UNA MAS!"

(McCarney Testimony Exh 13). The natural interpretation of UNA MAS in this context is generally more not specifically one more. In this respect, the statement sets forth "more of a good thing" not one more. Further, "More taste. More flavors. More freshness . . . UNA MAS." will lead the reader to believe that they will be back for more, not just one more. This is especially true since the United States consumer only has a general understanding of the Spanish language. Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L., 49 USPQ2d 2018, 2012 (T.T.A.B 1998). Turning to Applicant's menu, it includes the statement "Get more of what your really want!" which is positioned in close proximity to UNA MAS and which is used in an emblazoned manner. (McCarney Testimony Exh. 28).

While Applicant will argue that UNA MAS strictly means only "one more" which cannot be interpreted the same way as "little more," Applicant repeatedly uses the general "more" concept in the promotion of its restaurant services and in connection with the UNA MAS mark. This includes the notion of giving the consumer more of what they want and not just giving the consumer one more of an item. As with most services, the idea of giving more service is not quantifiable.

Applicant's use of the general "more" concept is very similar to Opposer's use of the "more" concept. Opposer repeatedly promotes providing more of what the consumer wants. Opposer's web site includes the slogan "We always give you a little more than anyone else." (McCarney Testimony Exh. 11). Opposer's original menu includes the phrase "Mexican Food with 'a little more'." (McCarney Testimony Exh. 5). Opposer's web site also includes a web page entitled "A Little More About The Mas." (McCarney Testimony Exh. 11).

The consumers of Opposer's and Applicant's services recognize the English equivalent of both POQUITO MAS and UNA MAS, namely, the "more" concept. This recognition is shown by the many articles relating to the restaurant services provided by either Opposer or Applicant which include the author's recognition of the translated meaning of the marks. For example, the author of the Daily Herald states "The restaurant - whose name means 'one more' - is popular in..." (ONOR 3, Att. 6). The author from The Washington Post writes "At Una Mas! (In Spanish it means "One more"), California native..." (ONOR 3, Att. 7). In the Pittsburgh Post-Gazette it reads "At Una Mas! (Spanish for 'one more')..." (ONOR 3, Att. 10). The author of the Nation's Restaurant News writes "Richard Hamner can't resist the urge to open Una Mas! ('One More!')" (ONOR 3, Att. 13). In The San Francisco Chronicle it reads "Started in San Jose not quite six years ago, Una Mas (meaning, one more) has been...." (ONOR 3, Att. 14). With respect to Opposer's POQUITO MAS mark, a restaurant critic Larry Lipson has entitled his discussion of POQUITO MAS as "A little more, senior" for many years. (ONOR 3, Att. 15-31). Another restaurant critic, Michelle Huneven, in the Los Angeles Times writes "While Poquito Mas is indeed a Mexican fast-food joint, it's also a little more, or rather, un poquito mas, than that." (ONOR 5, Att. 3).

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity of meaning and connotation in order to ascertain confusing similarity. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 23:36, pg. 23-116. Consumers increasingly understand these Spanish language words with the increasing bilingual population in the United States. See In re LarMor International, Inc., 221 USPQ 180 (TTAB 1983). Many U.S. consumers are likely to understand the Spanish language

significance of the POQUITO MAS trademark relative to the phrase "UNA MAS." This is especially true in view of both parties promotion of the "more" concept and in view of the fact that both serve Mexican-style food.

Indeed, it logically follows that as with Opposer, Applicant, and the authors of several articles, the consumer of restaurant services also logically recognize the 'more' concept and that the English equivalents of both POQUITO MAS and UNA MAS relates to more. This is especially true in the California areas where each of Opposer and Applicant currently operate. Furthermore, even if the consumer is not familiar with the Spanish language, Applicant's slogan ONE IS GOOD, BUT UNA MAS IS BETTER along with the numerous other references to the concept of "more" will most likely make the consumer at least vaguely aware of the concept of "more." Miguel Torres S.A. v. Casa Vinicola Gerardo Cesari S.R.L., 49 USPQ2d 2018, 2012 (T.T.A.B 1998). However, by not being fluent in the Spanish language, many will not distinguish between the slight variation in the more concept, namely, "little more" versus "one more," the meaning of POQUITO MAS and UNA MAS respectively. Most likely, the commercial impression left with many consumers is the vague notion of more which adds to the likelihood that confusion exists.

With respect to the slogan "ONE IS GOOD, BUT UNA MAS IS BETTER," it is Opposer's contention that UNA MAS is the dominant portion of the slogan and therefore this portion is the primary component of the comparison. While other elements do exist, they are weak in the trademark sense and are not sufficient to prevent a likelihood of confusion.

For all the above reasons, it is respectfully submitted that UNA MAS and ONE IS GOOD, BUT UNA MAS IS BETTER is substantially similar to POQUITO MAS in sight, sound, meaning and commercial impression.

F. THE FAME OF OPPOSER'S MARKS

Opposer's POQUITO MAS mark is a strong mark for Opposer's restaurant services. In this respect, POQUITO MAS is a creative use of Spanish words for Opposer's restaurant services. Furthermore, Opposer's use of POQUITO MAS for over 18 years in connection with its restaurant services has further strengthened Opposer's POQUITO MAS mark. The record shows that Opposer and its POQUITO MAS marks are well known. Restaurant critic, Michelle Huneven, from the Los Angeles Times describes POQUITO MAS as "a 'little more' than a 'Mexican fast-food joint,'" went on to write several years later that she has become "a Poquito Mas fan" and that "sometimes, nothing will do but the San Felipe shrimp tacos...." (ONOR 5, Att 2). Another restaurant critic, Larry Lipson who has for many years titled his discussions concerning Opposer, "A little more, Senor," ranked POQUITO MAS as "Best of the Valley." (ONOR 5, Att 1). Restaurant critic Merrill Shindler in a 1993 wrote that while "Poquito Mas looks, on the surface, like any number of small taquerias...this is food that definitely stands out from the crowd." (ONOR 5, Att 5). Jean T. Barrett writes "[w]hen I don't have all evening to savor a Mexican meal, I make a beeline for Poquito Mas, a small chain of taco stands...'The Mas,' as it is known around our house, serves terrific freshly prepared....." (ONOR 5, Att. 6). Another article in Westways, when describing POQUITO MAS states "[t]he prices befit a fast-food joint, but the food itself would shine in a white-tablecloth restaurant. Cheap eats." (ONOR 5, Att. 7). An article in the Daily Variety entitled "Top Chefs Know Where to Go

for Good Grub,” and talks about a well-known cook Michael Rosen who prepared food at a fundraiser for President Clinton, dines at POQUITO MAS for “quickie fast food stuff.” (ONOR 5, Att 8.). An author of an article in the Los Angeles Times writes “I have come to require semi-regular doses of Poquito Mas’ grilled shrimp tacos...[in] fact, just about everything in this upscale taco stand is as good as it gets....” (ONOR 5, Att 9). In 1997, POQUITO MAS made the “ELMER RECOMMENDS” list for restaurant standouts. (ONOR 5, Att. 10). The author of the Valley Weekened Calendar of the Los Angeles Times said that “[e]verything is first-rate at Poquito Mas.” (ONOR 5, Att. 11). The Zagat survey has recognized POQUITO MAS as a standout restaurant in its 1995 through 2002 surveys praising POQUITO MAS for having “the best Mexican fast-food in all of L.A.” (McCarney Testimony Exh. 35-41). These articles show that Opposer’s POQUITO MAS mark is well known and is known to represent a chain of restaurants that sell quality Mexican-style food. The many favorable reviews have also helped to strengthen the Opposer’s POQUITO MAS mark.

Opposer receives many e-mails which support the contention that the POQUITO MAS mark is strong for restaurant services. One patron writes that the food is excellent, however, “parking is difficult due to your great reputation!” (McCarney Testimony Exh. 23). Another patron’s e-mail discusses an out-of-town friend who insists that they eat at POQUITO MAS each time he is in town. (McCarney Testimony Exh. 23). One patron writes “[e]veryone who visited me from the Chicago area always raved about the food [a]nd would demand to go back a second time before the end of their trip. (McCarney Testimony Exh. 23). Many of the e-mails are requests to invest in the POQUITO MAS restaurant chain or just requests to open a POQUITO MAS restaurant closer to

where the writer lives. (McCarney Testimony Exh. 23). In one e-mail, the writer states that "the things I miss most about California is eating at your restaurant." (McCarney Testimony Exh. 23).

As with many other taqueria or fast-casual Mexican restaurants, including Opposer and Applicant, word-of-mouth is a large part of the advertisement for these services. In re Dixie Restaurants, Inc., 41 USPQ2d 1531 at 1534 (C.A.F.C. 1997); citing Giant Food, Inc v. Nation's Foodservice, Inc., 218 USPQ 390, 395 (C.A.F.C. 1983). Over 18 years of favorable reviews, word-of-mouth advertisements and other promotions have made Opposer's POQUITO MAS marks strong for its restaurant services.

G. ACTUAL CONFUSION EXISTS

Even though due to the current geographic separation between Opposer and Applicant, incidences of actual confusion are less likely to occur, several incidences have occurred and have occurred on regular occasion when the geographic gap has been bridged. Referring to Carl Karcher, the Board discussed geographic separation stating "...absence of actual confusion is easily explained by the fact that the parties operate in different geographic areas." At 1133. Furthermore, as will be discussed below in greater detail, as both Opposer and Applicant expand their respective businesses, the geographic gap will be eventually eliminated and the likelihood of confusion will increase substantially. Nonetheless, Applicant is seeking federal registration which is geographically unrestricted and would entitle Applicant to various presumptions under Section 7(b). These presumptions include the presumption of an exclusive right to use the mark for restaurant services nationwide.

Opposer currently operates its chain of Mexican, fast-casual style restaurants in and about Los Angeles, California. (McCarney Testimony 12, 1-14, 2 and Exh. 27). Applicant operates its chain of Mexican, fast-casual style restaurants in and about the San Francisco Bay area. (McCarney Testimony 81, 11-24 and Exh. 29). There is a geographic separation between Opposer and Applicant. However, when Kevin McCarney was on a business trip to San Francisco several years ago, he witnessed consumer confusion. (McCarney Testimony 96 and 97). In this respect, while on a plane going to San Francisco, McCarney had a conversation with the passenger next to him. In their discussion, McCarney indicated that he owned and operated a string of Mexican-style restaurants called POQUITO MAS. At that point, the passenger remarked "Oh, the UNA MAS chain up here." (McCarney Testimony 96, 10-11). In a separate trip north of Los Angeles, McCarney witnessed another incident of actual consumer confusion. While in Los Gatos, McCarney discussed his restaurant chain with a cashier at a local shop. (McCarney Testimony 96, 22-97, 7). When McCarney informed the cashier of the name POQUITO MAS, the cashier immediately responded with a question as to whether POQUITO MAS was connected with UNA MAS. (McCarney Testimony 97, 1-3). These instances, in view of the geographical separation, is persuasive evidence of how and why confusion exists and that the expansion into common geographic locations make confusion likely. It is clear that the reason for the confusion was when Mr. McCarney identified himself as owner of POQUITO MAS. There is no doubt that the reason for the question as to affiliation was the result of the similarities in the respective marks in view of the identical services.

Actual confusion need not be shown to establish likelihood of confusion. Nevertheless, even a single instance of actual confusion is illustrative of how and why confusion is likely. Molenaar, Inc. v. Happy Toys, Inc., 188 USPQ 469 (TTAB 1975). Furthermore, in view of the current geographical separation between Opposer and Applicant, even if there were no incidences of actual confusion, which is not the case, this would not be significant to show that there is no likelihood of confusion. Carl Karcher at 1133. In this respect, when there is geographic separation there is little or no opportunity for incidences of actual confusion. Id. at 1133. However, as is set forth above, when the geographic separation was transcended by McCarney's trip, confusion occurred.

H. THE EXTENT OF POTENTIAL CONFUSION

The potential confusion that would result if UNA MAS or ONE IS GOOD, BUT UNA MAS IS BETTER is allowed to proceed to registration is substantial. Because of the many similarities, the consumer will associate, and indeed has associated the phrase UNA MAS with the POQUITO MAS mark, believing Poquito Mas and Una Mas to be affiliated restaurants. Opposer desires to expand its restaurant and restaurant business into future markets. (McCarney Testimony 14, 12-25 and 15, 1-11). Opposer does not wish to be precluded in the future. As can be seen from the record, Applicant is currently expanding too. (McCarney Testimony Exh. 10 and 29). Applicant's web page states that Applicant plans 80 operational units by 1999 (McCarney Testimony Exh. 10). Further, between 1997 and 2002, Applicant went from under 20 restaurants to 32 restaurants. (McCarney Testimony Exh. 10 and 29). Based on these facts alone, Applicant and Opposer are likely to be in the same geographic locations in the near future. Though proximity of geographic location is not required under the Lanham Act, the actual proximity will result in even greater damages to Opposer,

potentially damaging the goodwill in the POQUITO MAS trademarks and the goodwill in Opposer's business. Indeed, reverse confusion could even result. The rate of expansion of Una Mas will drown out the senior user POQUITO MAS, ultimately destroying the goodwill and value Opposer has built up during 18 years of use of POQUITO MAS.

VI. SUMMARY OF LIKELIHOOD OF CONFUSION

There is a likelihood of confusion between Applicant's UNA MAS and ONE IS GOOD, BUT UNA MAS IS BETTER marks and Opposer's POQUITO MAS marks as a matter of law. The '266 and '590 applications and Opposer's registrations, which are subject to these proceedings, all recite "restaurant services." Accordingly, as far as these proceedings are concerned, the services, trade channels and class of consumer are identical. In addition, the recited "restaurant services" and the actual services provided by Opposer and Applicant include the highly competitive fast-food restaurants services which involve inexpensive entrees priced around \$5.00. This type of service are purchased casually, are subject to quick consumption and are subject to a lesser standard of purchasing care. The Board has held the purchase of this type of service is often is made on impulse. Furthermore, the selection of fast-food type restaurant services is often made by casual recollection of past experiences. As a result, the Board went on to hold that these circumstances "weigh in favor of a finding of likelihood of confusion." Carl Karcher at 1129 quoting Burger Chef, at 169. In essence, the degree of similarity necessary to show likelihood of confusion not substantial. In re Dixie at 1534, citing Century 21 at 1701. Furthermore, it is not whether the marks are distinguishable in a side-by-side comparison, it is whether based on the average purchaser's recollection, the marks can be distinguished. In re Continental Graphics at 1375; citing Sealed Air.

Nonetheless, POQUITO MAS and UNA MAS are substantially similar in appearance, sound, meaning, and commercial impression. Both POQUITO MAS and UNA MAS are formed by two Spanish words in the same two word format having the same last word "MAS."

With respect to meaning and commercial impression, POQUITO MAS and UNA MAS are virtually identical. The English translation of POQUITO MAS is "little more" and the English translation of UNA MAS is "one more." The phrases "little more" and "one more" are essentially the same in meaning and commercial impression, especially in view of its use in connection with restaurants and the Mexican nature of these restaurants. Under the doctrine of foreign equivalents, foreign words in common languages are translated into English to determine similarity of meaning and connotation in order to ascertain confusing similarity. *McCarthy on Trademarks*, Sect. 23:36 pg 23-116. The United States consumer is becoming increasingly familiar with the Spanish language. *In re LarMor*, 221 USPQ 180 (TTAB 1983). The record repeatedly confirms the recognition by the consuming public and that both Opposer and Applicant flaunt or draw attention to the idea of the general concept of more. However, by not being fluent in the Spanish language, many will not distinguish between the slight variation in the "more" concept, namely, "little more" versus "one more," the meaning of POQUITO MAS and UNA MAS respectively. Most likely, the commercial impression left with many consumers is the vague notion of more which adds to the likelihood that confusion exists. This in view of the casual recollections typically used to select certain types of restaurants, makes confusion likely.

Opposer's POQUITO MAS mark is a strong mark for Opposer's restaurant services. Opposer has used its POQUITO MAS mark for over 18 years in connection with its Mexican

restaurant services. The record confirms that over 18 years of favorable reviews, word-of-mouth advertisements and other promotions have made Opposer's marks strong.

Even though, due to the current geographic separation between Opposer and Applicant, incidences of actual confusion are less likely to occur, several incidences have occurred and have occurred on regular occasion when the geographic gap has been bridged. Furthermore, as Opposer and Applicant expand their respective businesses, the geographic gap will be eliminated and likelihood of confusion will increase substantially. However, even if there were no incidences of actual confusion, which is not the case, this would not be significant in view of the geographic separation. Carl Karcher at 1133.

Because of the close similarity, consumers will associate, and indeed have associated, the phrase UNA MAS with the POQUITO MAS mark, believing Poquito Mas and Una Mas to be affiliated restaurants. Both Opposer and Applicant desire to expand their respective restaurant chains. As a result, Opposer and Applicant are likely to be in the same geographic locations in the near future. Nonetheless, Applicant is seeking Federal registration which is geographically unrestricted and would entitle Applicant to various presumptions under Section 7(b). These presumptions include the presumption of an exclusive right to use the mark for restaurant services nationwide.

Finally, as the Board knows, all doubts surrounding the issue of likelihood of confusion should be resolved against Applicant, the newcomer, especially when balancing the interest of a well-established mark. Special Brands at 1285, citing Planter's Nut & Chocolate Company v. Crown Nut Company, Inc., 134 USPQ 504 (CCPA 1962). "The newcomer has the clear opportunity, if not

the obligation, to avoid confusion with the well-known marks of others." J & J Snack Foods Corp. v. McDonald's Corp., 18 USPQ 1889, 1892 (Fed. Cir. 1991). In fact, Applicant's own Thomson and Thomson trademark search report revealed Opposer's POQUITO MAS mark (ONOR 7 Att. 10).

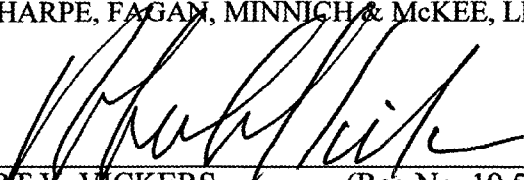
VII. CONCLUSION

Opposer has established that Opposer has priority over Applicant and has both used and registered its POQUITO MAS mark long prior to Applicant's first use of UNA MAS and/or the filing of either of the '266 or '590 applications. It is also respectfully submitted that Opposer has established that a likelihood of confusion exists as a matter of law. Each of the DuPont factors weighs heavily in Opposer's favor.

VIII. RELIEF REQUESTED

For all the above reasons, registration of UNA MAS and registration of ONE IS GOOD, BUT UNA MAS IS BETTER will cause confusion, cause mistake or deceive the purchasing public as to the source of the restaurant services. Therefore, under 15 U.S.C. § 1052(d), Applicant is not entitled to obtain trademark registration for either UNA MAS or ONE IS GOOD, BUT UNA MAS IS BETTER. Opposer respectfully requests that these consolidated opposition proceedings be sustained and that Applicant's '266 and '590 applications be refused.

Respectfully submitted,
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP

By: 
ROBERT V. VICKERS (Reg No. 19,504)
1100 Superior Avenue, Seventh Floor
Cleveland, Ohio 44114
Phone: 216-861-5582
Fax: 216-241-1666
Attorneys for Opposer
Kevin T. McCarney dba Poquito Mas

E. COMPARING FOREIGN WORDS AND ENGLISH WORDS

§ 23:36 Doctrine of foreign equivalents

West Key No. Digests References

Trade Regulation ☞ 185 to 188

KeyCite™: Cases and other legal materials listed in KeyCite Scope can be researched through West Group's KeyCite service on WESTLAW®. Use KeyCite to check citations for form, parallel references, prior and later history, and comprehensive citator information, including citations to other decisions and secondary materials.

Under the doctrine of "foreign equivalents," foreign words from common languages are translated into English to determine genericness,¹ descriptiveness,² as well as similarity of meaning and connotation in order to ascertain confusing similarity with English word marks.

The doctrine of foreign equivalents is not an absolute rule, for it does not mean that words from dead or obscure languages are to be literally translated into English for any and all trademark comparison purposes.³ The test is whether, to those American buyers familiar with the foreign language, the word would denote its English equivalent.⁴ The rationale of this rule is that a foreign word familiar to an appreciable segment of American purchasers may be confusingly similar to its English equivalent, or vice versa.

The doctrine of foreign equivalents should not be transformed into a mechanical and rigid doctrine. The purchaser of the goods does not, of course, see the English "equivalent" compared to the English language word mark alleged to be confusingly similar. He sees only a foreign word mark compared to an English word mark. When it is unlikely that the American buyer will translate the foreign mark

[Section 23:36]

¹ See §§ 12:41–12:45.

² See §§ 11:33–11:35.

³ In re Northern Paper Mills, 64 F.2d 998 (C.C.P.A. 1933); McKesson & Robbins, Inc. v. Charles H. Phillips Chemical Co., 53 F.2d 1011 (2d Cir. 1931). See §§ 11:33–11:35 and 12:41–12:45.


⁴ In re Hag Aktiengesellschaft, 155 U.S.P.Q. 598 (T.T.A.B. 1967); In re Zazzara, 156 U.S.P.Q. 348 (T.T.A.B. 1967).

CERTIFICATE OF SERVICE

I hereby certify that a copy of the attached BRIEF OF OPPOSER KEVIN T. McCARNEY dba POQUITO MAS was served on Applicant's Attorney by First Class, U.S. Mail, postage prepaid, at the below-stated address:

David J. Brezner, Esq.
Dorsey & Whitney, LLP
Four Embarcadero, Suite 3400
San Francisco, California 94111

on this 7th day of January, 2003.



NANCY M. GRAMS